

REMARKS

This communication responds to the Office Action dated May 29, 2008. No claims are amended, no claims are canceled, and no claims are added. As a result, claims 1, 4-7, 9-14, 16-17, 19, 22-25, and 27-29 are now pending in this Application.

§112 Rejection of the Claims

Claims 1, 4-7, 9-14, 16-17, 19, 22-25, and 27-29 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Applicant respectfully traverses.

First, it is respectfully noted that "... the specification and claims may not be rejected for lack of written description under Section 112, first paragraph, when details in the claims that are not described in the specification are within the level of ordinary skill in the art." *See* Patent Prosecution, Practice and Procedure Before The United States Patent Office, Ira H. Donner, 2002; citing *In re Skrivan*, 427 F.2d 801, (CCPA 1970). With this point in mind, it is respectfully noted that, contrary to the assertion by the Office, there is indeed disclosure of "disabling at least one previously-enabled size control function ...". The Application as originally-filed states:

"Window controls may be disabled such that the window may not be easily closed, resized, or obscured by other applications. ... Controls for the video presentation window may be disabled during the advertisement. ... As a streaming video program is presented, video window 100 may be manipulated using controls comprising the aforementioned minimize button 102, close button 104 and resize corner 106, or may be manipulated using options contained within one or more pull-down menus. ... The present invention overcomes the limitations of prior methods by employing an advertising window that is 'on top' of all other windows and cannot easily be closed, minimized, resized, or obscured. ... Some or all controls for the window are disabled at step 508. ... When the advertising is completed, the video window is returned to its previous size in step 610 and window controls may be re-enabled." Application, pg. 3, line 4 – pg. 7, line 29.

Thus, one of ordinary skill in the art would easily understand from the text of the Application, as-filed, that: (a) video windows can be manipulated using a variety of

controls, (b) that one of these controls can be a resize corner 106 control, (c) that some or all of the controls, including the resize corner control 106, can be disabled so that the window may not be easily resized, and (d) that the disabled controls, including a window sizing control, can be re-enabled (which establishes, in turn, that the disabled controls were previously enabled).

Second, the M.P.E.P. § 2164 *et seq.* notes that the burden is on the Examiner to establish a *prima facie* case to maintain a rejection of non-enablement with respect to the disclosure of a patent application under 35 U.S.C. § 112, first paragraph. Such a case requires:

1. a rational basis as to
 - a. why the disclosure does not teach, or
 - b. why to doubt the objective truth of the statements in the disclosure that purport to teach;
2. the manner and process of making and using the invention;
3. that correspond in scope to the claimed invention;
4. to one of ordinary skill in the pertinent technology;
5. without undue experimentation; and
6. dealing with subject matter that would not already be known to the skilled person as of the filing date of the application.

“The Examiner must provide evidence ... supporting each of these elements for a rejection under the first paragraph of § 112 to be proper.” See *Patent Prosecution, Practice and Procedure Before The United States Patent Office*, Ira H. Donner, pg. 691, 2002.

Since the specification clearly establishes the ability to disable and re-enable window controls, which plainly comprise window sizing controls, and since evidence supporting each of the required elements noted above (e.g., that one of ordinary skill would be unable to practice embodiments of the invention without undue experimentation) has not been presented, a *prima facie* case to maintain a rejection of non-enablement under § 112, first paragraph, has not been properly established. Reconsideration and withdrawal of this rejection is therefore respectfully requested.

§103 Rejection of the Claims

Claims 7, 9-11 and 23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Zigmond (U.S. Patent No. 6,698,020; hereinafter "Zigmond") in view of Kanter (U.S. Patent Application Publication No. 2002/0032608 A1; hereinafter "Kanter"). Claims 1, 4-6, 17, 19, 22, 24, 25 and 27-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Zigmond in view of Rashkovskiy (U.S. Patent No. 6,912,504; hereinafter "Rashkovskiy") and further in view of Kanter. Claims 12-14 and 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Siler (U.S. Patent Application Publication No. 2004/0133467 A1; hereinafter "Siler") in view of Rashkovskiy and further in view of Kanter. However, since a *prima facie* case of obviousness has not been established by the Office in each case, the Applicant respectfully traverses the rejection of these claims.

1) The Applicable Law

As discussed in *KSR International Co. v. Teleflex Inc. et al.* (U.S. 2007), the determination of obviousness under 35 U.S.C. § 103 is a legal conclusion based on factual evidence. See *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 7, 1336-37 (Fed. Cir. 2005). The legal conclusion, that a claim is obvious within § 103(a), depends on at least four underlying factual issues set forth in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17 (1966): (1) the scope and content of the prior art; (2) differences between the prior art and the claims at issue; (3) the level of ordinary skill in the pertinent art; and (4) evaluation of any relevant secondary considerations.

Therefore, the test for obviousness under §103 must take into consideration the invention as a whole; that is, one must consider the particular problem solved by the combination of elements that define the invention. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir.1985). The Examiner must, as one of the inquiries pertinent to any obviousness inquiry under 35 U.S.C. §103, recognize and consider not only the similarities but also the critical differences between the claimed invention and the prior art. *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990), *reh'g denied*, 1990 U.S. App. LEXIS 19971 (Fed. Cir.1990). The fact that a reference teaches away from a claimed invention is highly probative that the reference would not have rendered the claimed invention obvious to one

of ordinary skill in the art. *Stranco Inc. v. Atlantes Chemical Systems, Inc.*, 15 USPQ2d 1704, 1713 (Tex. 1990). When the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious. *Id.* p. 4 citing *United States v. Adams*, 383 U.S. 39, 51-51 (1966). Additionally, critical differences in the prior art must be recognized (when attempting to combine references). *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990), *reh'g denied*, 1990 U.S. App. LEXIS 19971 (Fed. Cir.1990).

Moreover, the Examiner must avoid hindsight. M.P.E.P. § 2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984)). That is, the Examiner cannot use the Applicant's structure as a "template" and simply select elements from the references to reconstruct the claimed invention. See *In re Gorman*, 933 F.2d 982, 987, 18 U.S.P.Q.2d (BNA) 1885, 1888 (Fed. Cir. 1991). The fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01.

Furthermore, the Court in *KSR* reaffirmed that "[a] factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of argument reliant upon ex post reasoning." *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2 d at 1397. See also *Graham v. John Deere Co.*, 383 U.S. at 36, 148 USPQ at 474.

2) *Application of § 103 to the Rejected Claims - Combining the References Does Not Supply All Claim Elements:*

Claims 7, 9-11 and 23 – Zigmond in view of Kanter:

Independent claims 7 and 23 recite "disabling at least one previously-enabled size control function of [a/said] video presentation window in response to said ad event signal". The Office admits that "Zigmond fails to teach disabling at least one previously-enabled size control function of the display window in response to the ad event signal." The Office goes on to assert that "Kanter discloses that a "user has no control over the ad window such as minimizing the ad in response to a control signal. See 0017." Office Action, pg. 4.

However, this is not the same as teaching or suggesting the feature of “disabling at least one previously-enabled size control function of [a/said] video presentation window,” as claimed by the Applicant in independent claims 7 and 23. As Kanter explicitly states, the “... user has no control over the ad window ...”. Kanter, para. [0017]. In other words, the ad window size control described by Kanter never was “previously-enabled” as claimed by the Applicant.

Since neither Zigmond nor Kanter disclose this claimed feature, no combination of these references can supply the missing element, and claims 7 and 23 should be in condition for allowance. In addition, any claim depending from a nonobvious independent claim is also nonobvious. See M.P.E.P. § 2143.03. Therefore, claims 9-11 should also be in condition for allowance, and the Applicant respectfully requests reconsideration and withdrawal of this rejection of claims 7, 9-11, and 23 under 35 U.S.C. § 103(a).

Claims 1, 4-6, 17, 19, 22, 24, 25 and 27-29 – Zigmond in view of Rashkovskiy, and further in view of Kanter:

Independent claims 1, 17, and 25 recite “disabling at least one previously-enabled size control function of said display window” (claims 1 and 17) and “adjusting said display window to a predetermined size in response to said ad insert event signal, wherein at least one previously-enabled size control function of the display window is disabled” (claim 25). The Office admits that “both Zigmond and Rashkovskiy fail to teach disabling at least one previously-enabled size control function of the display window.” As noted above, the Office goes on to assert that “Kanter discloses that a “user has no control over the ad window such as minimizing the ad. See 0017.” Office Action, pg. 7.

Again, this is not the same as teaching or suggesting the feature of “disabling at least one previously-enabled size control function of said display window” (claims 1 and 17) or “adjusting said display window to a predetermined size in response to said ad insert event signal, wherein at least one previously-enabled size control function of the display window is disabled,” (claim 25) as claimed by the Applicant in independent claims 1, 17, and 25, respectively. This is because Kanter explicitly states that the “... user has no control over the ad window ...”. Kanter, para. [0017]. In other words, the ad window size control described by Kanter never was “previously-enabled” as claimed by the Applicant.

Since neither Zigmond, nor Rashkovskiy, nor Kanter disclose this claimed feature, no combination of these references can supply the missing element, and claims 1, 17, and 25 should be in condition for allowance. In addition, any claim depending from a nonobvious independent claim is also nonobvious. *See* M.P.E.P. § 2143.03. Therefore, claims 4-6, 19, 22, 24, and 27-29 should also be in condition for allowance, and the Applicant respectfully requests reconsideration and withdrawal of this rejection of claims 1, 4-6, 17, 19, 22, 24, 25 and 27-29 under 35 U.S.C. § 103(a).

Claims 12-14 and 16 – Siler in view of Rashkovskiy, and further in view of Kanter:

Independent claim 12 recites “disabling at least one previously-enabled size control function of said video presentation window”. The Office admits that both “Siler and Rashkovskiy fail to teach disabling at least one previously-enabled size control function of the display window.” The Office goes on to assert that “Kanter discloses that a “user has no control over the ad window such as minimizing the ad. *See* 0017.” Office Action, pg. 12.

However, this is not the same as teaching or suggesting the feature of “disabling at least one previously-enabled size control function of said video presentation window,” as claimed by the Applicant in independent claim 12. This is because Kanter explicitly states that the “... user has no control over the ad window ...”. Kanter, para. [0017]. In other words, the ad window size control described by Kanter never was “previously-enabled” as claimed by the Applicant.

Since neither Siler, nor Rashkovskiy, nor Kanter disclose this claimed feature, no combination of these references can supply the missing element, and claim 12 should be in condition for allowance. In addition, any claim depending from a nonobvious independent claim is also nonobvious. *See* M.P.E.P. § 2143.03. Therefore, claims 13-14 and 16 should also be in condition for allowance, and the Applicant respectfully requests reconsideration and withdrawal of this rejection of claims 12-14 and 16 under 35 U.S.C. § 103(a).

CONCLUSION

The Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone the Applicant's representative at (210) 308-5677 to facilitate prosecution of this Application. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date AUGUST 27, 2008

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 28 day of June, 2008.

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